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EXAMINER

NGUYEN, TAN D

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



## DETAILED ACTION

### *Response to Amendment*

1. The amendment of 6/30/09 has been entered. Claims 94, 108-109, 100, 104, are pending and have been amended. Claims 1-93, 101-103, and 105-107 have been canceled. The claims comprise 3 groups:

- 1) Apparatus: 94, and 108-109,
- 2) Method: 100, and
- 3) medium (CRSM): 104.

For simplicity, method claim 100 (1 claim) will be examined first.

### *Finding of Facts*

1) the term “threshold” is defined as:

Main Entry: **thresh·old**

Function: *noun*

Etymology: Middle English *thresshold*, from Old English *threscwald*; akin to Old Norse *threskjoldr* threshold, Old English *threscan* to thresh

Date: before 12th century

**2 a : GATE, DOOR b (1) : END, BOUNDARY**; *specifically* : the end of a runway (2) : the place or point of entering or beginning : **OUTSET** <on the threshold of a new age>

**3 a** : the point at which a physiological or psychological effect begins to be produced <has a high threshold for **pain**>

**3 b** : a level, point, or value above which something is true or will take place and below which it is not or will not

2) the term “average” is defined as:

Function: *noun*

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**1 a** : a single value (as a mean, mode, or median) that summarizes or represents the general significance of a set of unequal values **b** : MEAN 1b

**2 a** : an estimation of or approximation to an arithmetic mean **b** : a level (as of intelligence) typical of a group, class, or series <above the average>

**3** : a ratio expressing the average performance especially of an athletic team or an athlete computed according to the number of opportunities for successful performance

— **on average** or **on the average** : taking the typical example of the group under consideration <prices have increased *on average* by five percent>

**synonyms** AVERAGE, MEAN, MEDIAN, NORM mean something that represents a middle point. AVERAGE is the quotient obtained by dividing the sum total of a set of figures by the number of figures <scored an *average* of 85 on tests>. MEAN may be the simple average or it may represent value midway between two extremes <a high of 70° and a low of 50° give a *mean* of 60°>. MEDIAN applies to the value that represents the point at which there are as many instances above as there are below <*average* of a group of persons earning 3, 4, 5, 8, and 10 dollars an hour is 6 dollars, whereas the *median* is 5 dollars>. NORM means the average of performance of a significantly large group, class, or grade <scores about the *norm* for fifth grade arithmetic>.

2) the term “incentive” is defined as:

Function: *noun*

Etymology: Middle English, from Late Latin *incentivum*, from neuter of *incentivus* stimulating, from Latin, setting the tune, from *incentus*, past participle of *incinere* to play (a tune), from *in-* + *canere* to sing — more at CHANT

Date: 15th century

: something that incites or has a tendency to incite to determination or action

**synonyms** see MOTIVE

See *Merriam-webster Online Dictionary*, available at <http://www.merriam-webster.com/dictionary/event> (visited on November 06, 2009).

### ***Principles of Laws***

2. Note: Independent claim 94 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 94, 108-109 (apparatus) are rejected under 35 U.S.C. 101 because the claimed invention is directed to more than one class of statutory subject matter.

The independent claim 94 begin by disclosing a “server apparatus”, however the claims contains many method steps, i.e. “which communicates..”, “for discriminating...”, “transmitting...”, “ordering...”, “database which stores...”, “... when it has fallen below...”, “why the collection rate is greater than 100%”, “if the user does not respond or adjust

...", "corresponding to ...", etc., or respectively use language that is used in the claim of a method claim. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548).

Similarly, dependent claims 108-109 also contains many method steps, i.e. "includes data ...", "said calculator calculates ...", "...calculates ...", "data includes data indicating ...", "calculates ...", or respectively use language that is used in the claim of a method claim and are rejected for the same reason set forth above.

### ***Claim Rejections - 35 USC § 112***

5. Claims 94, 100, 104, and 108 and 109 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**1) Claims 94, 100, 104** are vague and indefinite since the claims uses "method steps" as shown above, in an apparatus claims. See IPXL Holdings. Va. Amazon.com (Fed. Circuit 2005). System claim that includes a method step is invalid as indefinite since it's not clear what is the scope of the apparatus claim.

Note: In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See (1) MPEP 2114. (2) *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does, i.e. "device which acts

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or performs ...". (3) *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990).

Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. (4) *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

2) In independent claims, it's note Claims 94, 100 and 104 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are:

1) the relationship between the "a rate analyzer" and "a counter-measurer" with the previous elements such as "a second calculator", and subsequent elements such as "an exception handler" or "a generator"? The "exception handler" deals with "the collecting rate" and not the "**average collecting rate**" as shown in the "the counter-measurer".

3) In claim 94, the use of the "pronoun" term "it" is vague since it's not clear what the exact "term" it's replacing. Language in the claim should be accurate and not subject to guessing or what is referred to?

4) Similarly independent claims 100 and 104, which have similar limitations to independent claim 94, are rejected for the same reasons set forth in the rejections of item (2) above.

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5) In independent claims 94, 100 and 104, the amended language of "an average collection rate" is vague because it's not clear what are the units, items, collection period or frequency, or with respect to what item or from what items or with respect to what user, etc., this "average" value refers and what is the units, items, collection period or frequency, of the "threshold" value?

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was



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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**9. Claims 100 (method), 104 (computer program product), and 94 (apparatus), 108-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Applicant Admitted Prior Art (AAPA) in view of (2) JUNGER '899 and (3) JOHNSON et al.**

As of 6/30/09, independent method claim 100 is as followed:

100. (currently amended): A method of controlling a server apparatus, which communicates with a plurality of client computers through a computer network, for discriminating log-in information received from each client computer, and transmitting data for ~~the purpose of~~ ordering a new consumable, to a logged-in client computer, said method comprising the steps of:

(a) inputting order data of a new consumable inputted by a user who ~~uses the order screen displayed on a monitor of~~ using the logged-in client computer;

(b) inputting collecting data of a used consumable returned from a ~~the~~ user;

( c) storing the order data and the collecting data in relation with the log-in information to a database;

(d) calculating a collecting rate from a plurality of the order data and a plurality of the collecting data stored in said database;

(e) calculating the user' s incentive data based on the collecting rate in a unit of the log-in information;

(f) calculating an average collecting rate and comparing it with a predetermined threshold;

(g) improving the average collecting rate when it has fallen below the predetermined threshold;

(h) sending an inquiry to the user regarding why the collecting rate is greater than 100%, and suspending operation of the said second calculating step if the user does not respond or adjust the collecting rate otherwise;

(i) generating price data of the new consumable in accordance with the user' s incentive data in the unit of the log-in information;

(j) providing the logged-in client computer with the price data corresponding to the log-in information of that ~~to display a price of the new consumable on the order screen~~ client computer; and

(k) providing, in response to an instruction of the user, the logged-in client computer with data ~~of a confirmation screen to be displayed~~ to the user, which includes the order data, the collecting data, a collection rate, and the incentive data as a discount rate of a new consumable corresponding to the log-in information of that client computer.

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**Applicant Admitted Prior Art (AAPA)**, as shown under the “Background of the Invention”, specification pages 1-3, Figs. 1-2, discloses a method for managing business including **sales, credits (incentives or stimulus) for returned used sale items** (used office supplies) from collection center, comprising the steps:

a) and b) collecting and inputting data for respective user/client and wherein the data containing information about items/cartridges ordered (sales), used items/cartridges returned by the user/client and collected at the collection center or the like (dealer),

c) storing the above data,

(d) and (e) calculating the client's collecting rate and incentive (credit) data compliance with the collecting data above wherein the calculating is carried out by collates collecting data of the customer with a record of orders accepted (sale);

(f) setting a target (threshold) for collecting rate of various used office supplies or items with **incentives** for improving the collecting rate or “**SET INCENTIVE**”

{see Fig. 2, step (S7), page 2, par. [0009], page 3, pars. [0011-0012]}

(k) providing information about the collecting rate and incentive data on a report to the client by conventional method, which is by mail.

As for the limitation of average collecting rate, AAPA teaches the calculating of the client's collecting rates of various types or kinds of cartridges, the use of “an average value” for the collection rate for all types of cartridges for convenience would have been if the exact numbers and types of cartridges are not essential or critical in determining the incentive values. Also, in view of the teachings of “setting incentives”

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for improving the collecting rates of various types of cartridges and “informing the clients of the collecting and incentives status”, this would inherently “improve” the collecting rate because the user is aware of the actual numbers and would return more used cartridges in order to obtain the incentives (credits) given by the dealer. Alternatively, it would have been obvious for the user, being informed by the dealer of the actual numbers or collection rates and incentives, would return more used cartridges in order to obtain the incentives (credits) given by the dealer.

AAPA fairly teaches the claimed invention except for carrying out the business management on a computer server network and steps (h), (i), (j) and (k).

In another system/method for verifying product sale transactions and processing product returns using a wide area computer network (Internet) linking multiple entities involved in a sale transaction, **JUNGER '899** discloses an effective **real-time** system for receiving, collecting, crediting and verifying product returned in compliance with a return policy, purchase transaction, etc., to permit reduced prices to the customer and/or provide improved operating margins for the manufacturer and/or retailer while achieving 2 major savings while maintaining consumer confidence and satisfaction (goodwill):

(1) reducing the number of improper or fraudulent returns such as expired items, wrong items, no sales record or receipts, wrong stores or different prices, defective products, etc., which diminishing store/dealer profit margins, and

(2) improving efficiency and reducing overhead in handling proper returns.

{see cols. 3-4, and 5-6, Figs. 1, 6, 8, 9, 10A, 12A, 13, 16A, and 16F}.

The system of JUNGER '899 enables a store clerk or the like (collection center) to obtain **real-time** electronic verification of a particular product sale transaction as well as the currently available return/warranty options for a particular product presented for return. {see col. 5, lines 30-35, Figs. 1, 6, 8 "**Internet**", 9, 10A, 12A, 13, 16A, and 16F}

Therefore, it would have been obvious to a person having ordinary skill in the art (herein after as "PHOSITA") at the time of the invention was made to modify the teachings of AAPA by replacing the slow, ineffective, and costly manual system of AAPA with real-time computer automation connecting all parties involved on an Internet computer network as taught by JUNGER '899 to obtain a highly efficient system for receiving, collecting, crediting and verifying product returned in compliance with a return policy, purchase transaction, etc., to permit reduced prices to the customer and/or provide improved operating margins for the manufacturer and/or retailer while obtaining benefits cited above.

JOHNSON ET AL fairly discloses a fully integrated sales automation system comprising a server, which communicates with a plurality of client computers through a **computer server network** comprising website (Internet based system) for discriminating log-in information received from each client computer, and transmitting data of an order screen used by a user for the purpose of ordering a new consumable, to a logged-in client computer, said server comprising:

{see col. 7, lines 29-65 "...Fig. 2. ...a server-based back office system 200",  
Figs. 1, 4, 5, 7, 12, 13, 15, 17}

a) a first input section, arranged to input order data of a new consumable inputted by a user who uses the order screen displayed on a monitor of the logged-in client computer;

{see Figs. 1, 13, 17, cols. 5-6}

b) a second input section, arranged to input collecting data of a used consumable returned from the user;

{see Figs. 15A "**Trade-In Info**", "Allowance", "**Refurbished**", "Expected Sales Value", Fig. 15B, "Quote Info", "**Discount Description**", "**Discount Amount**", cols. 27-28}

c) a database which stores the order data and the collecting data in relation with the log-in information;

{see Figs. 1, element 116, 15A-15F, col. 4, lines 5-47}

d) a first calculator, arranged to calculate a value data about sales or sale transactions such as quote, finance and proposal for potential customer purchase from a plurality of the order data and a plurality of the data stored in said database;

{see Figs. 1, 2, 4, 15A-15F, cols. 4-5}

e) a second calculator, arranged to calculate a value data about incentives based on a plurality of order data and other customer purchase data;

{see Figs. 10A, element 1014, Figs. 12, and 15A, 15B and 15C}

h) an exception handler, arranged to send an inquiry to the user about an event

{see Fig. 19, element 201, such as 1904, 1902, 1906 and 1908, col. 32, lines 48-60}

i) a generator, arranged to generate price data of the new consumable in accordance with the incentive data in the unit of the log-in information; and

{see Fig. 13, 1302, Figs. 15A-15C, col. 15, lines 15-67 “...*finance module 410 ... calculate...edit... **price, net trade value**, .... Payment calculation engine....*”, cols. 23-24, 28-29}

(j) and (k) a provider, arranged to provide the logged-in client computer with the price data corresponding to the log-in information of that client computer to display a price of the new consumable on the order screen, and, in response to an instruction of the user, to provide the logged-in client computer with data of a confirmation screen to be displayed to the user, which includes the order data, the collecting data, the collecting rate, and the incentive data as a discount rate of a new consumable corresponding to the log-in information of that client computer.

{see Figs. 3, “Web Site”, Fig. 10A, element 1041, 1032, Fig. 12, element 1212, 1218, 1220, Fig. 13 and 15A-15C, cols. 28-29}.

Note on Figs. 15A-15C, JOHNSON ET AL discloses the general concept of listing every data or issues, “**Order Info**”, “**Trade-in Info**”, “**Quote Info**”, “**Finance Info**”, **such as incentive data, credit, net trade value data, collecting data**, etc., related to the customer transactions in details for easy monitoring and sales proposals {see col. 28, lines 5-10}. Therefore, in view of this listing teaching, the displaying or listing of any desired data such as collecting rate, collecting data, etc., would have been obvious as mere listing of other desired data related to the customer past and future transactions.

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Therefore, it would have been obvious to a person having ordinary skill in the art (herein after as "PHOSITA") at the time of the invention was made to modify the system of AAPA/JUNGER '899 with Internet based computer network automation system of JOHNSON ET AL and including the steps (i), (j) and (k) in order to present the customer with complete customer information for a sale proposal.

Also, in view of the teaching of an exception handler, arranged to send an inquiry to the user about an event in JOHNSON ET AL and the teaching of potential fraudulent returns due to wrong items, no sales record or receipts, wrong stores or different prices, defective products, etc., which **diminishing store/dealer profit margins**, as taught by JUNGER '899, it would have been obvious to send a message in the query asking the user why the collecting rate is greater than 100% and suspending operation if the user does not respond and adjust the collecting rate otherwise to minimize losses.

10. **As for independent computer program product claim 104 and apparatus claim 94** and which are the respective computer program product and apparatus claims to carry out the respective independent method claim 100 above, they are rejected over the respective computer program product and apparatus to carry out the respective method as taught by AAPA /JUNGER '899 and JOHNSON ET AL above {see JUNGER '899 Figs. 1, 6, 8, 10, 12, 13 and 16A. Alternatively, the setting up of a computer program product and apparatus to carry out the respective method claim 100 above would have been obvious to a PHOSITA as mere carrying out the respective computer program product and apparatus to achieve its method scope.



As for dep. claims 108-109 (part of 94 above), which deal with well known data collection parameters, kind or type of consumable and incentive/award points determining parameters as a function of collecting state and order state, these are fairly taught in AAPA page 3, lines 1-3 or JOHNSON ET AL Figs. 15A, 15B.

### ***Response to Arguments***

11. Applicant's arguments filed 6/30/09 have been fully considered but they are not persuasive in view of the new ground of rejections which are caused by applicant's amendment of the claims.

### **Conclusion**

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) **US 2002/0013744 by TSUNENARI et al**, fairly teaches a Web-based system for efficient monitoring of product purchase and return, similar to JUNGER '899, and is cited for applicant's awareness for potential use in the future if needed to avoid citing duplicate rejections. See Figs. 1, 2, 7.

2) US Patent 6,167,382 by SPARKS et al, discloses a method for ordering, purchasing of items using the Internet with displaying of "order confirmation" {see Fig. 61} and "Order Complete" {see Fig. 62} for multiple logged-in client computers {see Figs. 1-59}. The teaching of complete "order confirmation" and "order Complete" are cited here for applicant's awareness of potential use in the future if needed to show well known teachings of step (g) in claim 100 above.

3) JP 6096094, 1994, discloses an article and device for collecting the article with merits/bonuses given to a user who cooperates with the collection system, similar to the teachings of AAPA cited above. It's cited for applicant's awareness for potential use in the future if needed to avoid citing duplicate rejections.

No claims are allowed.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
11/6/09